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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,741	12/01/2000	Gerrit Bleumer	P00,1718	2355
26574	7590	08/11/2005	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,741

Applicant(s)

BLEUMER, GERRIT

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15-18, 20-22 and 25-34 is/are rejected.
7) ☒ Claim(s) 19, 23 and 24 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 3/19/01 & 4/13/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119 is acknowledged.

2. The proposed drawing correction filed 13 April 2005 has been approved.

2.1 The combined set of drawings, that is figs. 1 & 7 as filed 19 March 2001 and figs. 2-6 & 8-12 as filed 13 April 2005 are acceptable to the examiner.

3. The disclosure is objected to because of the following informalities:

A) the following errors have been noted in the specification:

(1) as can be seen in figs. 11 & 12 and from the context of the disclosure in the paragraph located between page 15, line 21, and page 16, line 6 of the substitute specification filed 13 April 2005, "For example, the date stamp 84 can include postal matter data that characterizes a physical property of the mail piece on which the date stamp is stamped. If the date stamp is cut out from one mail piece and attempted to be affixed to another mail piece, it is unlikely that the second mail piece will have identical physical properties as the original mail piece. In the example shown in Figure [[10]] 11, an embodiment of a date stamp 84A is shown wherein the postal matter data characterize a type of packaging material of the original mail piece. In the embodiment of the date stamp 84B shown in Figure [[11]] 12, the postal matter data characterize the surface structure of the packaging material of the original mail piece.", the references to figs. 10 and 11, should be to -Figure 11--, and -Figure 12--, respectively as shown above.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

5. Claims 15-18, 22 & 25-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5.1 In regard to claims 15-18, 22 & 25-34, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, that is essential information/data and/or structure is missing so that as claimed invention does not work as a whole toward accomplishing the desired results and therefore one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using what applicant has disclosed and claimed as the invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to how the limitation of:

(1) machine claim 15 “an inspection unit remote from said franking apparatus for inspecting unique coin identification information in the date stamp to determine, from said data unique coin identification information, whether said date stamp has been multiply used”; and

(2) process claims 22 & 25, “inspecting the mail piece at a location remote from said device and determining, from the information embodied in the electronic coin in the date stamp on the mail piece, whether the electronic coin in the date stamp on the mail piece has been multiply used.” (see claim 22 and the reference to this function in claim 25),

may be performed by the invention as recited in these claims, since the invention as recited in these claims does not record/save the detected information that is contained within any one or more of the inspected electronic coins so that the machine of claim 15 and the process of claims 22 & 25 may in fact perform the claimed function of determining whether or not the information contained within any one subsequently inspected electronic coin has in fact been previously used and therefore been multiply used so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim.

B) in regard to claims 30-32 and why machine readable data characterizing either:

(1) “a physical property of a mail piece” (claim 30); or

(2) “a type of packaging material of said mail piece” (claim 31); or

(3) "a surface structure of packaging material of said mail piece" (claim 32);

is included in the "date stamp" on the mail piece, since the invention as recited in these claims does not use this information for any purpose and does not detect either:

(1) the "physical property of a mail piece"; or

(2) the "type of packaging material of a mail piece"; or

(3) the "surface structure of packaging material of a mail piece";

so that the detected information may be compared to the characterization information contained within the detected date stamp so as to provide a claimed invention that would achieve the creditable utility that has been set forth in the preamble of the claim.

5.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6.1 Claims 15-18, 22 & 25-34 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

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B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

6.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board

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of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

6.1.3 As can be seen from claims 15-18, 22 & 25-34, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 15-18, 22 & 25-34 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim. Therefore, these claims do not provide an operative useful machine/process, see In re Musgrave, supra, with in the meaning of machine/process as used in 35 U.S.C. § 101, see In re Sarkar, supra.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.1 Claims 20 & 21, are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Peyret (5,688,056) or McCooey.

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7.2 Claims 20 & 21, are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Whitehouse et al (6,005,945).

7.3 Claims 20 & 21, are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Heiden et al (2002/0091545 or 6,438,530).

7.4 In regard to claims 20 & 21, either Peyret ('056) or McCooey or Whitehouse et al ('945) or Heiden et al ('545 or '530) disclose a computer implemented machine/process which under the control of an operating program accessible by the machine/process provides the functions of a postage metering system. To this end, the disclosed postage metering system in which previously obtained electronically money, that is electronic coins are stored in an central accounting unit or fee module, are debited to pay for postage as the system dispenses, that is consumes, postage. Further, in these systems when postage is to be dispensed, the required amount of postage is appropriately accounted for and a machine readable individualized postage indicia/stamp containing encoded information including at least:

A) the time and date the indicia was generated;

B) the postage amount; and

C) an unique number associated with the item of mail that is used to verify the indicia;

is generated for each item of mail. After the generated postage indicia/stamp has been printed on the item of mail by a conventional printer under the control of the postage metering system and the item of mail has been placed into the delivery system, the indicia is inspected to determine if the mailer is attempting fraud on the postal authority by mailing an item mail with an authorized duplicate indicia.

7.4.1 In regard to claim 21, it is noted that each of Peyret ('056) or McCooey or Whitehouse et al ('945) or Heiden et al ('545 or '530) disclose postage metering systems that are implemented using a general purpose printer and a general purpose computer that has been programmed to perform postage metering functions.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

8.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) either Peyret (5,688,056) or McCooey or Whitehouse et al (6,005,945) or Heiden et al (2002/0091545 or 6,438,530) disclose a computer implemented machine/process which under the control of an operating program accessible by the machine/process provides the functions of a postage metering system in which previously obtained electronically money/coins are stored in an accounting unit or fee module, and then are debited in order to pay for postage that is consumed/printed/dispensed by the postage metering system dispenses postage by generating and printing an postage indicia containing a machine readable individualized postage indicia containing encoded information including at least (1) the time and date the indicia was generated; (2) the postage amount; and (3) an unique number associated with the item of mail that is remotely used by the Postal Authority to verify the indicia.

B) however, in regard to claims 15 & 22, the prior art does not teach or suggest machine/process that performs the functions of the including information within the postage indicia or machine readable stamp information that identifies the unique "electronic coin" that has been used as a "postage fee unit" in order to pay for the postage fee unit consumed when franking/printing the mail piece with the postage indicia or machine readable stamp and then the "electronic coin" information is used to determine if the postage indicia or machine readable stamp has been used multiple times. Claims 16-19 & 23-34 are allowable for the same reason.

10. The examiner has cited prior art of interest, for example:

A) Herbert (EP 0856816) disclose the use of an ink which can not be copied to detect duplicate postage indicia.

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B) Kara et al (6,249,777) disclose the use of an unique number contained with in an indicia to detect copies and prevent fraud.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (571) 273-6802.

11.2 The fax phone number for OFFICIAL FAXES is (571) 273-8300.

11.3 The fax phone number for AFTER FINAL FAXES is (571) 273-8300.

07/27/05


Edward R. Cosimano
Primary Examiner A.U. 3639